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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/091,204

Applicant(s)

ONG ET AL.

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-17, 19-29, 31-42 and 44-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-17, 19-29, 31-42 and 44-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/05/2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/01/2007.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the communication response to the communication received on 07 May 2007.
2. Claims 4, 18, 30 and 43 were cancelled.
3. Claims 1-3, 5-17, 19-29, 31-42, and 44-48 are presented for examination.

Response to Arguments

4. Applicant's arguments see Applicant's remark, pages 2-4 filed on 07 May 2007, with respect to the rejection of claim(s) 1, 16, 29 and 42 under USC 102(e) has been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **Sena et al. US patent #: 7,039,643 B2.**

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 5-17, 19-29, 31-42, and 44-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,200,668 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of patent # 7,200,668 B2 contain(s) every element of claim(s) 1, 3, 5; 16, 17, 19; 29; and 42 of the instant application and as such anticipate(s) claim(s) 1-3, 5-17, 19-29, 31-42, and 44-48 of the instant application.

7. Claims 1-3, 5-17, 19-29, 31-42, and 44-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of co-pending application #: 10/090,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 10, 11 of co-pending application #: 10/090,893 contain(s) every element of claim(s) 1, 6, 9, 10, 13 of the instant application and as such anticipate(s) claim(s) 1-3, 5-17, 19-29, 31-42, and 44-48 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-

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type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Drawings

8. The drawings are objected to because the typing errors in figures 3, 4, and 6 regarding to the word “conveter”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 5-17, 19-29, 31-42, and 44-48 are rejected under 35 U.S.C. 102(e) as being anticipated by **Sena et al. US patent #: 7,039,643 B2.**

11. As to claim 1, Sena discloses a system comprising:

a server (*Figs. 7, 8, server 300*) configured to store documents (*digital media files*) in one or more server format(s) each supported by one or more application(s) of the server, wherein the server, wherein the documents are available to one or more device(s) (*mobile or electronic portable devices, PDAs*) via a network (*Internet*);

a small device (*Abstract, Figs. 7, 8, a PDA device 404; customer computers 350*) configured to couple to the server (*Figs. 7, 8, server 300, col. 4, line 20 – col. 5, line 49*);

wherein the server is further configured to plug a converter module (*transformation module 460*) into a framework configured to accept one or more pluggable module(s) (*Figs. 7, 8, modules 420, 450, 480*).

wherein the converter module is configured to generate a document in a small device format (*Figs. 7, 8, col. 4, line 20 – col. 5, line 49; col. 8, line 40 – col. 9, line 62*);
and

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wherein the server is further configured to provide the document in the small device format to the small device (*Fig. 7, col. 9, lines 11-26*).

wherein the converter module is further configured to

receive a modified version (*a changed/modified version*) of the document in the small device format from the small device (*Figs. 6, 14, steps 1154-1156; col. 8, lines 35-38*); and

generate a modified version of the document in the server format from the modified version of the document in the small device format (*Figs. 7, 10, col. 4, line 20 – col. 5, line 49; col. 9, lines 11-26; col. 10, line 51 – col. 12, line 35*).

12. As to claim 2, Sena discloses wherein the server formats include office document formats (*table 1A, PowerPoint presentation, Star Office, col. 12-14*).

13. As to claim 3, Sena discloses wherein, to generate a document in one of the one or more small device formats, the converter module is further configured to exclude (*to remove*) one or more format features of the document in the server format from the document in the small device format (*Fig. 5B, col. 7, lines 52-65*).

14. As to claim 5, Sena discloses wherein, to generate a modified version of the document in the server format from the modified version of the document in the small device format, the converter module is further configured to restore (*to integrate*) one or more format features of the document in the server format excluded from the document in the small device format (*Figs. 6, 14, col. 4, line 20 – col. 5, line 49; col. 7, line 4 – col. 17, line 35*).

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15. As to claim 6, Sena discloses wherein the server is further configured to plug a merger module into the framework; and wherein the merger module is configured to merge (*to combine*) the modified version of the document in the server format with the document in the server format to generate a synchronized version of the document in the server format (*Fig. 10, col. 10, line 51 – col. 12, line 35*).

16. As to claim 7, Sena discloses wherein the server is further configured to plug a differencing module (*updating*) into the framework, and wherein the differencing module is configured to determine differences (*old vs. current versions, updates*) between the modified version of the document in the server format and the document in the server format (*Fig. 9, col. 4, line 20 – col. 5, line 49; col. 10, lines 16-67*); and provide the determined differences to the merger module, wherein each determined difference indicates changed content of the modified version of the document in the server format (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

17. As to claim 8, Sena discloses wherein, for each of the determined differences, the merger module is further configured to merge corresponding changed content of the modified version of the document in the server format with the document in the server format (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

18. As to claim 9, Sena discloses receiving a modified version of the document in the small device format from the small device (*Fig. 6, col. 8, lines 35-39*).

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plug a merger module, a differencing module into the framework (*Figs. 7, 8, col. 4, line 20 – col. 5, line 49; col. 8, line 40 – col. 9, line 62*);

generate a version of the document in an interim format (*intermediate format*) from the document in the server format (*Fig. 9, col. 4, line 20 – col. 5, line 49; col. 9, line 63 – col. 11, line 12*)

wherein the converter module is further configured to generate a modified version of the document in the interim format from the modified version of the document in the small device format (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*);

wherein the differencing module is configured to determine differences between the modified version of the document in the interim format and the version of the document in the interim format, wherein each determined difference indicates changed content of the modified version of the document in the interim format (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*);

wherein, for each of the determined differences, the merger module is further configured to merge corresponding changed content of the modified version of the document in the interim format with the version of the document in the interim format to generate a synchronized version of the document in the interim format (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*).

19. As to claim 10, Sena discloses wherein the server is further configured to generate a synchronized version of the document in the server format from the synchronized version of the document in the interim format (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*).

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20. As to claim 11, Sena discloses wherein the server is further configured to: unplug (*remove*) the converter module from the framework; plug (*insert*) a different converter module into the framework (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

21. As to claim 12, Sena discloses wherein the different converter module is configured to generate documents in a different one of the one or more small device formats from documents in a different one of the one or more server formats; and generate modified versions of documents in the different server format from modified versions of documents in the different small device format (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

22. As to claim 13, Sena discloses wherein the server is further configured to plug a merger module into the framework, wherein the merger module is configured to merge modified versions of documents in the server format with corresponding original versions of the documents in the server format to generate synchronized versions of the documents in the server format (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

23. As to claim 14, Sena discloses wherein the server is further configured to plug a differencing module into the framework, wherein the differencing module is configured to determine differences between modified versions of documents in the server format and corresponding original versions of the documents in the server format (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

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24. As to claim 15, Sena discloses wherein the server comprises a converter factory configured to generate the converter module, the merger module and the differencing module for plugging into the framework (*Figs. 6-10, col. 4, line 20 – col. 5, line 49; col. 7, line 66 – col. 8, line 58; col. 10, lines 16-50*).

25. As to claim 16, Sena discloses a server (*Figs. 7, 8, server 300*) comprising: a processor (*Fig. 8, 304*); a memory (*Fig. 8, 310*) operable to store program instruction, wherein the program instructions are executable by the processor to:

implement a framework configured to received pluggable converter modules configured to convert documents in one or more office document formats to and from one or more small device document formats (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*);

plug one of the converters into the framework; and wherein the converter module is executable by the processor to generate a small device document in particular one of the one or more small device formats from one of the documents in a particular one of the one or more office document formats (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*); wherein the program instructions are further executable by the processor to send the small device document to a small coupled to the server (*Figs. 7, 9, col. 4, line 20 – col. 5, line 49; col. 9, line 11 – col. 11, line 12*);

wherein the converter module is further executable by the processor to

receive a modified version (*a changed/modified version*) of the document in the small device format from the small device (*Figs. 6, 14, steps 1154-1156; col. 8, lines 35-38*); and

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generate a modified version of the document in the server format from the modified version of the document in the small device format (*Figs. 7, 10, col. 4, line 20 – col. 5, line 49; col. 9, lines 11-26; col. 10, line 51 – col. 12, line 35*).

26. Claims 17, 19-24 correspond apparatus claims of claims 3, 5-10; therefore, they are rejected under the same rationale as in claims 3, 5-10.

27. Claim 25 correspond apparatus claim of claims 11, 12; therefore, it is rejected under the same rationale as in claims 11, 12.

28. Claims 26-28 correspond apparatus claims of claims 13-15; therefore, they are rejected under the same rationale as in claims 13-15.

29. Claim 29 corresponds the method claim of claims 1, 3, 5; therefore, it is rejected under the same rationale as in claims 1, 3, 5.

30. Claims 31-32 corresponds the method claim s of claims 6-7; therefore, they are rejected under the same rationale as in claims 6-7.

31. Claims 33-34 corresponds the method claims of claims 9-10; therefore, they are rejected under the same rationale as in claims 9-10.

32. Claim 35 corresponds the method claims of claims 9, 7; therefore, it is rejected under the same rationale as in claims 9, 7.

33. Claim 36 corresponds the method claim of claim 10; therefore, it is rejected under the same rationale as in claim 10.

34. Claims 37-38 corresponds the method claims of claims 12-13; therefore, they are rejected under the same rationale as in claims 12-13.

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35. Claim 39 corresponds the method claim of claims 11, 12; therefore, it is rejected under the same rationale as in claims 11, 12.

36. Claim 40 corresponds the method claim of claim 9; therefore, it is rejected under the same rationale as in claim 9.

37. Claim 41 corresponds the method claim of claim 13; therefore, it is rejected under the same rationale as in claim 13.

38. Claim 42 corresponds the computer readable medium claim of claims 1, 3, 5; therefore, it is rejected under the same rationale as in claims 1, 3, 5.

39. Claim 44 corresponds the computer readable medium claim of claim 7; therefore, it is rejected under the same rationale as in claim 7.

40. Claim 45 corresponds the computer readable medium claim of claims 9, 10; therefore, it is rejected under the same rationale as in claim 9, 10.

41. Claim 46 corresponds the article of manufacture claim of claims 12, 11; therefore, it is rejected under the same rationale as in claims 10, 11.

42. Claims 47, 48 corresponds the computer readable medium claim of claims 12, 13; therefore, they are rejected under the same rationale as in claims 12, 13.

43. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen
Examiner
Art Unit 2142



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER